

REMARKS

The non-final Office Action dated October 2, 2009 and the references cited therein have been carefully studied. Favorable reconsideration and allowance are respectfully requested in view of the foregoing amendments and the following remarks.

I. Claim Status and Amendments

Claims 1-10 were pending in this application when last examined. Claim 4 has been withdrawn as being directed to non-elected subject matter. Claims 1-3 and 5-10 have been examined on the merits and stand rejected.

By way of the present amendment, claims 1-3 and 5-9 have been amended.

Support for the amendment to claim 1 can be found in the disclosure, for example, on page 7, line 15 to page 8, line 2, Figure 11, and original claim 1. Claims 2-3 and 5-9 have been amended in a non-narrowing manner to better conform to U.S. claim form and practice. Support can be found in the claims as filed.

Claims 4 and 10 have been cancelled without prejudice and/or disclaimer thereto. Applicants reserve the right to file a divisional or continuation application on any cancelled subject matter.

New claims 11-19 have been added that correspond to original claims 1-10 but better correspond to US claim form and practice and provide a slightly different scope of protection. Support for new claims 11 and 12 can be found in the disclosure, for example, on page 5, lines 3-26, on page 7, line 15 to page 8, line 2, and in original claim 1. New claims 13, 14, 15, 16, 17, 18, and 19 correspond to original claims 2, 3, 5, 6, 7, 8, and 19, respectively. Further support for new claims 17 and 18 can be found in the disclosure at page 5, line 15 to page 6, line 3.

No new matter has been added by the above claim amendments.

Claims 1-3, 5-9, and 11-19 are pending upon entry of this amendment and these claims define patentable subject matter for the reasons noted herein.

The specification has been amended at the paragraph beginning on page 7, line 12, to correct an obvious typographical error by replacing “FIG. 4” with “FIG. 11.” It is obvious that the surrounding discussion at page 7 relates to Fig. 11 and not Fig. 4. No new matter has been added.

II. Foreign Priority

Acknowledgment by the PTO of the receipt of Applicant’s papers filed under Section 119 is noted.

III. Indefiniteness Rejection

Claim 9 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the claimed invention for the reasons set forth in item 3 on page 3 of the Office Action.

The Examiner states that there is insufficient antecedent basis for the term “in that said rods are inserted” in claim 9. The present amendment obviates this concern by amending claim 9 to depend from claim 7 and to recite “vertical rods” to thereby comply with US practice with respect to antecedent basis. Withdrawal of this rejection is requested.

IV. Prior Art Rejections

US Patent No. 3,959,065

Claims 1, 2, and 6 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Ashcroft (US Patent No. 3,959,065) for the reasons set forth in item 5 on pages 3-4 of the Office Action. The rejection is respectfully traversed.

It is well established that to anticipate a claim, a cited prior art reference must disclose each and every element of the claimed invention. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *See also* M.P.E.P., Eighth Ed., Rev. 7 (July 2008) at § 2131. Applicants respectfully submit that the rejection should fall because Ashcroft fails to disclose each and every element of main claim 1 and new claim 11.

Independent claim 1, as amended, recites: “means for mounting a heat-shrinkable annular band onto said container comprise at least one vertically movable support plate for the annular band, which is disposed vertically, and the means for causing the annular band to adhere by heat-shrinkage are supported on said support plate.” Similarly, new claim 11 recites: “at least one vertically movable support plate that is attached to and supports both the mounting device and the heater.” It is respectfully submitted that Ashcroft fails to disclose these features of the independent claims.

The rejection is based in part on the examiner’s broad interpretation of the term “associated” in claim 1, which is intended to mean “functionally related to” instead of “connected to” or “supported on”. However, as seen above, claim 1 has been revised to remove this broad interpretation by replacing “associated” with “supported on said support plate”, according to the embodiment depicted in Fig. 11 and discussed at page 7, line 15 to page 8, line 2. Again, new claim 11 requires a similar feature by the recitation “at least one vertically movable support plate that is attached to and supports both the mounting device and the heater.” Ashcroft fails to disclose or suggest this feature.

Ashcroft discloses an apparatus for producing a container with a shrinkable surface covering of plastic thereon. As shown in Fig. 1 of Ashcroft, the apparatus includes a plurality of mandrels 29 mounted on a turret 10a, a conveyor 11 transporting a plurality of glass bottles B above

the turret 10a, a cylindrical turret frame 10c below the turret 10a, and a circular cam 33 extending around the turret frame 10c. At the base of each mandrel 29 there is a push-up bar 30 sleeved thereon and connected to a vertically slideable operating rod 31. Each of the operating rods 31 also connects to the circular cam 33 through a cam roller 33a.

When the apparatus is in operation, the turret 10a rotates counter-clockwise so that the mandrels 29, the push-up bars 30, and the operating rods 31 move at the same speed as the glass bottles B. Also, because the cam roller 33a moves along the contour of the circular cam 33, each operating rod 31 moves circularly as well as slides vertically, and thus reciprocally pushes the corresponding push-up bar 30 up and down vertically.

Before the conveyer 11 transports a glass bottle B above a mandrel 29, a plastic strip 34a is wound on the mandrel 29 and seamed to form a sleeve S. When the bottle B is transported to a position above a mandrel 29, the operating rod 31 pushes the push-up bar 30 up vertically, and the push-up bar 30 slides along the mandrel 29 to push the sleeve S all the way up until it is sleeved onto the glass bottle B from the bottom thereof (column 3, line 32 through column 4, line 38).

After the sleeves S is sleeved onto the glass bottle B, the glass bottle B is carried to enter into a space between two opposed nozzle members 39a, 39b. There, the sleeve S is sufficiently heated by elongated nozzle means 39 (Figs. 1-4) and shrinks firmly about the glass bottle B (column 5, lines 23-46). As shown in Figs. 2-4 of Ashcroft, the nozzle member 39a is supported by the vertical members 40 secured to the turret frame 10c (Fig. 1) and the nozzle member 39b is supported on vertical standards 41 connected to an overhead frame 28 of the conveyor 11.

In the paragraph bridging pages 3-4 of the Office Action, the examiner relies on the turret 10a in Ashcroft as reading on the term “movable support plate.” The examiner interprets the operating rod 31 in Ashcroft as the means capable of mounting a heat shrinkable annular band onto a container, and the examiner asserts that the operating rod 31 comprises the turret 10a.

Applicant respectfully disagrees and submits that Ashcroft fails to disclose or suggest that for which it is being offered.

First, as set forth above, contrary to the examiner’s assertion, feature 10a in Ashcroft does not disclose a vertically movable support plate as claimed. In this regard, the operating rod 31 and the turret 10a of Ashcroft are two independent elements in that the operating rod 31 does not comprise the turret 10a.

Second, although Ashcroft states that the turret 10a rotates counter-clockwise, no portion in Ashcroft discloses that the turret 10a is also vertically movable. In fact, since the push-up bar 30 is reciprocally driven up and down by the circular cam 33, and at the lowest point the push-up 30 bar rests on the turret 10a (shown in Fig. 1, also see column 3, lines 44-47), the turret 10a cannot possibly move up because it will otherwise interfere with the movement of the mandrels 29. Therefore, the turret 10a of Ashcroft cannot read on the feature of the vertically movable support plate in claims 1 and 11 of the present application.

Third, on page 4 of the Action, the examiner further indicates that the push-up bar 30 of Ashcroft reads on the term “movable support plate” in claim 1 of the present application. Applicant respectfully disagrees with this position. As the name “push-up bar” suggests, element 30 in Ashcroft is a circular shaped bar, not a plate as recited in the claims and as interpreted in the rejection. Further, the only function of the Ashcroft push-up bar 30 is to slide along its corresponding mandrel 29 to push and mount the sleeve S up onto the glass bottle B. However, the

heating means (the nozzle members 39a, 39b) are not supported by the push-up bar 30. Therefore, even if the push-up bar 30 were able to read on a support plate, which is not, Ashcroft would still have failed to disclose a support plate that is vertically movable to mount the sleeve S onto the glass bottle B and supports the heating nozzle members 39a, 39b.

For at least these reasons, Ashcroft fails to disclose elements that read on the “means for mounting a heat-shrinkable annular band onto said container comprise at least one vertically movable support plate for the annular band, which is disposed vertically, and the means for causing the annular band to adhere by heat-shrinkage are supported on said support plate” of claim 1. Similarly, Ashcroft fails to disclose the “at least one vertically movable support plate that is attached to and supports both the mounting device and the heater” of claim 11.

Accordingly, claim 1 and its dependent claims 2 and 6 are patentable over Ashcroft. Claim 11 is also patentable over Ashcroft for the same reasons with respect to claim 1, as discussed above. Withdrawal of the rejection is therefore respectfully requested.

US Patent No. 3,763,496

Claims 1, 2, and 6 have been rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 3,763,496 for the reasons in item 6 on pages 4-5 of the Office Action. The rejection is respectfully traversed.

To start, Applicant requests clarification as to this rejection. First, it should be noted that the inventor of US Patent No. 3,763,496 is Miller, not Amberg, as listed on page 4 of the Office Action. Second, in making the rejection, the examiner relies on Fig. 9 and cites to means 71-73 and 77 of US 3,763,496. However, the Miller patent only discloses eight figures and there are no elements 71-73 and 77 disclosed therein. Further, the invention of the Miller patent is a necktie bar for preventing staining or spilling liquid onto a necktie. In this regard, it is believed

that the invention in US 3,763,496 to Miller is completely unrelated to the claimed subject matter and indeed it is too far removed from the claimed subject matter to be prior art. Thus, it is possible that the reference to US 3,763,496 was a typographical error on the part of the examiner. A correct citation of the reference art is respectfully urged if the Examiner wishes to utilize the same reference in the next Office Action. For this reason, the rejection should be withdrawn.

Further, in the event that the examiner cites a new piece of prior art in the next Office Action to correct the apparent typographical error, then the Action should be non-final, because the new citation would constitute a new ground of rejection that was not necessitated by Applicant's amendment, and the apparent error was not on the part of the Applicant.

Nonetheless, to the extent that the examiner intended to rely on the Miller patent (US 3,763,496), Applicant respectfully submits that the rejection should fall because the cited patent fails to disclose any element in claims 1 and 11 of the present application. The cited patent fails to disclose: a device for supporting and transporting at least one container suspended in an erect position acting from above on the container; a means for mounting a heat-shrinkable annular band onto the container acting from below; means to cause the label to adhere to the container by heat-shrinkage; wherein the means for mounting a heat-shrinkable annular band onto said container comprise at least one vertically movable support plate to transport the annular band vertically, and the means for causing the annular band to adhere by heat-shrinkage are supported on said support plate.

In view of the above, it is clear that the cited patent does not disclose each and every element in claims 1 and 11 of the present application. Thus, claim 1 and its dependent claims 2 and 6 are novel over the cited patent. Claim 11 is also patentable over the cited patent for the same reason as that of claim 1. Withdrawal of the rejection is therefore respectfully requested.

Ashcroft in view of Bolen

Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ashcroft in view of Bolen (US Patent No. 3,523,052) for the reasons in item 8 on page 5 of the Office Action. This rejection is respectfully traversed.

To start, the above arguments with respect to the rejection of main claim 1 over Ashcroft are reiterated herein by reference. Claim 3 depends on claim 1.

The secondary reference to Bolen fails to remedy the above-noted deficiencies in Ashcroft.

Bolen discloses an apparatus for applying tubular heat shrinkable labels 8 to containers 3. As clearly shown in Fig. 1 of Bolen, the segments of the heat-shrinkable annular label 8 are cut from the roll 9 by the cutter 10 and then are placed over the containers 3. This portion of the apparatus does not have a vertically movable support plate to transport the labels 8 vertically, as called for in claims 1 and 11 of the present application.

Also, the heat shrink tunnel F is located away from the cutter 10 and is fixed over the transportation belt 1. Therefore, Bolen also fails to disclose a vertically movable support plate to support a heating means, as called for in claims 1 and 11 of the application.

Because Bolen fails to make up for the deficiencies of Ashcroft with respect to claims 1 and 11, the proposed combinations in item 8 of the Office Action at least fail to disclose or teach the vertically movable plate to transport the label and support the heating means, as called for in claims 1 and 11. Therefore, claims 1 and 11 are patentable over the proposed combinations. Accordingly, claim 3 is also patentable over the proposed combinations at least by virtue of its dependency from claim 1. Withdrawal of the rejection is respectfully requested.

US 3,767,496 in view of Marchesini

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over US 3,767,496 in view of Marchesini (US Patent No. 4,991,377) for the reasons in item 9 on pages 5-6 of the Office Action. This rejection is respectfully traversed.

The arguments set forth above with respect to main claim 1 and the rejections over US 3,767,496 are reiterated herein by reference. In this regard, it is noted that claim 5 depends on claim 1.

Marchesini fails to remedy the above-noted deficiencies in US 3,767,496. Marchesini discloses an apparatus using heat to shrink and join a cap of a capsule to a body of the capsule. However, Figs. 1-3 of Marchesini clearly do not make up for the deficiencies of '496 with respect to claims 1 and 11 of the present application. Therefore, combining '496 with Marchesini would also fail to disclose or suggest each and every element in claim 1 of the present application. Accordingly, claim 5 are patentable at least by virtue of its dependency from claim 1 and inclusion of the features recited therein.

Withdrawal of this rejection is therefore respectfully requested.

Ashcroft in view of Bolen

Claims 7-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ashcroft or US 3,767,496 in view of Konstantin (US Patent No. 4,514,966) and Lerner et al. (US Patent No. 5,483,783) for the reasons in item 10 on pages 6-7 of the Office Action. This rejection is respectfully traversed.

The arguments set forth above with respect to claim 1 and the rejections over Ashcroft and US 3,767,496 are reiterated herein by reference. It should be noted that claims 7-10 depend on main claim 1.

First, since claim 10 has been cancelled, the rejection for claim 10 is moot.

Second, Konstantin and Lerner fail to remedy the above-noted deficiencies in Konstantin and Lerner.

Konstantin discloses an apparatus for applying a tubular heat-shrinkable band 3' to a container 4. As illustrated in Figs. 1 and 3 of Konstantin, the band 3' is first opened by a band open assembly, then is held by a striper assembly C and placed over the container 4 from the top thereof. Although the striper assembly C of Konstantin moves vertically, similar to Bolen, Konstantin does not disclose a vertically movable support plate to transport the band 3' vertically and support a heating means, as called for in claims 1 and 11 of the present application.

Lerner also discloses an apparatus for applying a tubular heat-shrinkable sleeve to a container. However, Lerner also does not disclose a vertically movable support plate to transport the band 3' vertically and support a heating means, as called for in claims 1 and 11 of the present application.

Because Konstantin and Lerner all fail to make up for the deficiencies of Ashcroft or US 3,767,496 with respect to claims 1 and 11, the proposed combinations in item 10 of the Office Action at least fail to disclose or teach the vertically movable plate to transport the label and support the heating means, as called for in claims 1 and 11. Therefore, claims 1 and 11 are patentable over the proposed combinations. Accordingly, claims 7-9 are also patentable over the proposed combinations at least by virtue of their dependency from claim 1.

Thus, withdrawal of the rejection is respectfully requested.

V. Conclusion

Having addressed all the outstanding issues, the amendment is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance, and favorable action thereon is requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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